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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/707,733

01/08/2004

Timothy Noel Hentschel

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03/16/2009

GAZDZINSKI & ASSOCIATES

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SAN DIEGO, CA 92127

EXAMINER

JOSEPH, TONYA S

ART UNIT

PAPER NUMBER

3628

MAIL DATE

DELIVERY MODE

03/16/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/707,733	Applicant(s) HENTSCHEL ET AL.	
	Examiner TONYA JOSEPH	Art Unit 3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 36-58 is/are pending in the application.
- 4a) Of the above claim(s) 39-58 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 36-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
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| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 01/30/2009 has been entered.

Election/Restrictions

1. Newly submitted claims 39-58 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- a. Claims 36-38 drawn to a method of facilitating hotel reservations
- b. Claims 39-54 drawn to a system for facilitating travel transactions.
- c. Claims 55-58 drawn to a computer server for facilitating the creation of a travel reservation.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II-III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination I and III has

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separate utility such as a system for hotel reservations and a bidder interface set-up system. See MPEP § 806.05(d).

3. The examiner has required restriction between subcombinations usable together. Where applicant elects a subcombination and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);

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(d) the prior art applicable to one invention would not likely be applicable to another invention;

(e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 39-58 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Status of Claims

Claims 17-38 have been previously examined. Claims 39-58 have been added. Claims 17-35 have been cancelled. Claims 39-58 have been withdrawn. Thus claims 36-38 are presented for examination.

Response to Arguments

Applicant's arguments with respect to claims 36-38 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 36-38 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

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6. Claim 36 is directed to a series of steps. In order for a series of steps to be considered a proper process under § 101, a claimed process should either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials). *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). Thus, to qualify as patent eligible, these processes must positively recite the other statutory class to which it is tied (e.g., by identifying the apparatus the accomplishes the method steps), or positively recite the subject matter that is being transformed (e.g., by identifying the product or material that is changed to a different state). Claim 36 identifies neither the apparatus performing the recited steps nor any transformation of underlying materials, and accordingly are directed to non-statutory subject matter.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 36-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moshal et al. U.S. Pre-Grant Publication No. 2001/0042041 A1 in view of Ghouri et al. U.S. Pre-Grant Publication No. 2002/0082978 A1.

9. As per Claim 36, Moshal teaches populating a database with a plurality of participating bidders (see para. 69 lines 2-8); configuring a plurality of reverse auction

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parameters (see para. 44 lines 11-16; para. 88 and 89); providing an online form to receive postings from a plurality of potential buyers (see para. 260 and Fig. 12); performing a reverse auction in accordance with at least one said reverse auction parameter (see para. 113 lines 4-6); transmitting an offer to at least one of said plurality of potential buyers, wherein said offer is generated from an accepted bid (see para. 253); wherein said reverse auction allows at least one said participating bidder to submit more than one said bid in response to said posting; and (see para. 71 lines 3-7). Moshal does not explicitly teach the method taught by Ghouri providing contact information for a bidding party of said accepted bid to at least one potential buyer to enable direct communication with a posting party of said accepted bid to complete the transaction (see para. 73-75). It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the system of Moshal to include the teachings of Ghouri to provide participant contact. Moshal teaches a plurality of potential buyers.

Examiner Notes: While Ghouri teaches the limitation, "to enable direct communication with a posting party of said accepted bid to complete the transaction", it is merely a statement of intended use and as such is afforded little patentable weight.

10. As per Claim 37, Moshal in view of Ghouri teaches the method of claim 36 as described above. Moshal further teaches wherein at least one bid in said plurality of bids is an automated bid (see para. 55 lines 7-11).

11. Claims 38 is rejected under 35 U.S.C. 103(a) as being unpatentable over Moshal et al. U.S. Pre-Grant Publication No. 2001/0042041 A1 in view of Ghouri et al. U.S. Pre-

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Grant Publication No. 2002/0082978 A1 in further view of Pathak U.S. Pre-Grant Publication No. 2002/0016760 A1.

12. As per Claim 38, Moshal in view of Ghouri teaches the method of claim 36 as described above. Moshal further teaches wherein said plurality of bids includes a first bid and a second bid, wherein said plurality of participating bidders comprises a first bidder and a second bidder (see para. 91), Moshal does not explicitly teach the limitation taught by Pathak wherein said first bid is hidden from said second bidder (see para. 10-12). It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the methods of Moshal and Ghouri to include the teachings of Pathak to preserve bidder confidentiality.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TONYA JOSEPH whose telephone number is (571)270-1361. The examiner can normally be reached on Mon-Fri 7:30am-5:00pm First Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Hayes can be reached on 571 272 0847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Tonya Joseph
Examiner
Art Unit 3628

/John W Hayes/
Supervisory Patent Examiner, Art Unit 3628